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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/697,906 | 10/29/2003 | Albert K. Chin | 23488-07961 | 9199 |

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EXAMINER

BERTRAM, ERIC D

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3766

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/697,906 | Applicant(s) CHIN ET AL. | |
| | Examiner Eric D. Bertram | Art Unit 3766 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7 and 12-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4,7 and 12-28 is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/05, 12/05, 1/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 11/1/2005, 12/8/2005, and 1/17/2006 were filed in compliance with the provisions of 37 CFR 1.97.

Accordingly, the information disclosure statements are being considered by the examiner.

Drawings

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because of problems with the character of lines, numbers and letters used in the drawings. Please see the attached Notice of Draftperson's Patent Drawing Review for more information. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Response to Arguments

3. Applicant's arguments filed 1/9/2006 regarding claim 1 have been fully considered but they are not persuasive. The applicant argues that Bowers (US 3,920,024), which discloses the conventional threshold testing method absent from Weiss (US 4,235,246), does not disclose "sensing electrical signals" as is recited in claim 1. However, it is clearly stated in Bowers that electrical sensing of a body organ (e.g. the heart) is continuous, and the signals are analyzed until a physiological activity is sensed,

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indicating that the threshold of the organ has been met (Col. 17, line 54-Col. 18, line 6). Since Weiss discloses that conventional threshold testing means should be used while probing for an optimum stimulation location on the heart (Col. 7, lines 55-60), and Bowers describes a method for conventional threshold testing of the heart, it would have been obvious to combine the two references. Furthermore, even though Weiss is silent as to sensing signals from the heart, he describes the use of a probe 38 (Col. 5, lines 1-30), which, given its broadest reasonable interpretation, suggests a device capable of gathering or sensing information from the tissue. Therefore, it would have been obvious and proper to combine the two references, as described below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss '246 in view of Bowers '024. Weiss discloses the applicant's basic inventive method including temporarily positioning an electrode at locations about the heart, which in this case involves the physician probing the heart wall with a stimulating needle probe 38 (Col. 5, line 5). By probing at different target locations, the physician is analyzing the patient threshold (a selected parameter) and then affixing a cardiac electrode at the one preferred stimulating location based on the analysis (Col. 5, line 6). Weiss discloses that determining the patient threshold and the best location to attach a cardiac electrode is done using "conventional threshold testing means" (Col. 7, line 59), but is silent as to what these means are. Specifically, Weiss does not explicitly disclose sensing electrical signals while performing "conventional threshold testing." Attention is directed to the secondary reference of Bowers, which describes a method for threshold testing of the heart. Bowers discloses continuously sensing electrical activity from the heart, supplying stimulation signals to the heart and then determining from the sensed signals the threshold level of the heart (Col. 17 and 18, claim 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention from the

teaching of Bowers to modify the method of Weiss by using a threshold testing system involving delivering both stimulation signals and then sensing signals from the heart in order to locate the preferred position on the heart to attach an electrode.

Allowable Subject Matter

8. Claims 3, 4, 7 and 12-28 are allowable over the prior art of record

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D. Bertram whose telephone number is 571-272-3446. The examiner can normally be reached on Monday-Thursday and every other Friday from 9-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert E. Pezzuto
Supervisory Patent Examiner
Art Unit 3766

Eric D. Bertram
Examiner
Art Unit 3766

EDB